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OFFICE OF PETITIONS

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In re Application of	:	
Leventhal et al.	:	
Application No. 10/633,179	:	DECISION ON APPLICATION
Filed: August 1, 2003	:	FOR
Atty Docket No.25739-024	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT", filed March 18, 2009, which is properly treated under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be increased from three hundred twenty three (323) days on the basis, in part, that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is granted to the extent indicated herein.

However, the determination of patent term adjustment at the time of mailing of the Notice of Allowance remains THREE HUNDRED TWENTY-THREE (323) days.

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On December 18, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 323 days. Applicants timely filed the instant application for patent term adjustment<sup>2</sup>.

Applicants dispute the reduction of 192 days for their response filed October 20, 2006. Applicants assert they should have been assessed a period of reduction of 91 days for applicant delay in responding to the non-final Office action of January 11, 2006. Applicants assert that they filed a response to the non-final Office action, accompanied by a request for an extension of time with the third month (and fee) on July 11, 2006. Thus, the date of July 11, 2006, should have been used for their date of response and a period of reduction of 91 days should have been entered.

Applicants are correct. A review of the application history reveals that no response to the non-final Office action of January 11, 2006, was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed August 22, 2006. The record establishes that, in response, on September 6, 2006, applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed November 14, 2006, the petition was granted on the basis that applicants had shown that a response was filed on July 11, 2006.

Applicants did fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action within the meaning of § 1.704(b), but not by 192 days. The date of receipt of the response to the non-final Office action was July 11, 2006, which was three months and 91 days after the non-final Office action was mailed. See 37 CFR 1.704(b). It is, therefore, appropriate to enter a reduction of the patent term adjustment of 91 days.

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<sup>2</sup> The issue fee was paid on March 18, 2009. Accordingly, applicant timely filed the instant request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.704(b) with the payment of the fee set forth in 37 CFR 1.18(e).

Accordingly, the period of reduction of 192 days is being removed and a period of reduction of 91 days is being entered.

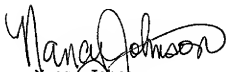
However, the response filed July 11, 2006 contained an omission. This omission was corrected by way of the filing of the compliant amendment on October 20, 2006. Accordingly, pursuant to 37 CFR 1.704(c)(7), a period of reduction of 101 days is being entered for the period beginning on the day after the date a reply containing an omission was filed, July 12, 2006, and ending on October 20, 2006, the date of filing of the response correcting the omission.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 323 days (606 days of Office delay - 283 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to the patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of revised PALM screen

# PALM INTRANET

Day : Wednesday

Date: 9/30/2009

Time: 18:46:06

## PTA Calculations for Application: 10/633179

Application Filing Date:	08/01/2003	PTO Delay (PTO):	606
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	283
Post-Issue Petitions:	0	Total PTA (days):	323
PTO Delay Adjustment:	0		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
99	09/30/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		101	
98	09/30/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		91	
97	09/30/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	192		
90	12/18/2008	MAIL NOTICE OF ALLOWANCE			
89	12/17/2008	ISSUE REVISION COMPLETED			
88	12/17/2008	DOCUMENT VERIFICATION			
87	12/17/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
86	12/16/2008	NOTICE OF ALLOWABILITY			
81	11/18/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
80	11/18/2008	REFERENCE CAPTURE ON IDS			
79	11/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	12/11/2008	DATE FORWARDED TO EXAMINER			
77	11/18/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
76	12/11/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
73	11/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
72	11/18/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
71	09/16/2008	FINISHED INITIAL DATA CAPTURE			
70	08/26/2008	EXPORT TO INITIAL DATA CAPTURE			
69	08/22/2008	MAIL NOTICE OF ALLOWANCE			
68	08/22/2008	ISSUE REVISION COMPLETED			
67	08/22/2008	DOCUMENT VERIFICATION			
		NOTICE OF ALLOWANCE DATA VERIFICATION			

66	08/22/2008	COMPLETED			
65	08/22/2008	CASE DOCKETED TO EXAMINER IN GAU			
64	08/18/2008	NOTICE OF ALLOWABILITY			
60	07/07/2008	NEW OR ADDITIONAL DRAWING FILED			
59	07/17/2008	DATE FORWARDED TO EXAMINER			
58	07/07/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
57	07/17/2008	DATE FORWARDED TO EXAMINER			
56	07/07/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		91	52
55	07/17/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
54	07/07/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
53	07/07/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
52	01/07/2008	MAIL FINAL REJECTION (PTOL - 326)	321		46
51	01/03/2008	FINAL REJECTION			
48	12/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
47	10/20/2007	DATE FORWARDED TO EXAMINER			
46	10/20/2006	RESPONSE AFTER NON-FINAL ACTION		192	30
45	09/23/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
43	12/11/2006	MAIL NOTICE OF RESCINDED ABANDONMENT			
42	12/10/2006	NOTICE OF RESCINDED ABANDONMENT IN TCS			
41	12/04/2006	DATE FORWARDED TO EXAMINER			
40	09/06/2006	SUPPLEMENTAL RESPONSE			
39	07/11/2006	NEW OR ADDITIONAL DRAWING FILED			
38	07/11/2006	AMENDMENT CROSSED IN MAIL			
34	11/14/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
33	09/06/2006	PETITION ENTERED			
32	08/22/2006	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
31	08/21/2006	ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
30	01/11/2006	MAIL NON-FINAL REJECTION			
29	01/06/2006	NON-FINAL REJECTION			
28	01/12/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			

27	12/14/2005	CASE DOCKETED TO EXAMINER IN GAU			
26	10/27/2005	DATE FORWARDED TO EXAMINER			
25	10/13/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
24	10/13/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	07/13/2005	MAIL RESTRICTION REQUIREMENT	285		-1
22	07/11/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
21	06/03/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
20	06/03/2004	CASE DOCKETED TO EXAMINER IN GAU			
19	01/12/2004	REFERENCE CAPTURE ON IDS			
18.7	01/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	01/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	12/30/2003	NEW OR ADDITIONAL DRAWING FILED			
16	08/01/2003	NEW OR ADDITIONAL DRAWING FILED			
15	08/01/2003	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
14	03/31/2004	TRANSFER INQUIRY TO GAU			
13	02/23/2004	APPLICATION RETURN FROM OIPE			
12	02/12/2004	APPLICATION RETURN TO OIPE			
11	02/12/2004	APPLICATION IS NOW COMPLETE			
10	02/12/2004	APPLICATION DISPATCHED FROM OIPE			
9	02/12/2004	APPLICATION IS NOW COMPLETE			
8	12/30/2003	ADDITIONAL APPLICATION FILING FEES			
7	12/30/2003	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
6	10/30/2003	CORRECTED PAPER			
4	10/20/2003	CASE CLASSIFIED BY OIPE			
3	10/20/2003	CLEARED BY OIPE CSR			
2	09/18/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/01/2003	INITIAL EXAM TEAM NN			

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#### **EXPLANATION OF PTA CALCULATION**

#### **EXPLANATION OF PTE CALCULATION**

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